REMARKS

In the Office Action, the Examiner rejected claims 1-27. By the present Response, Applicants have amended claims 1, 9, 11-13, 20, and 24-27, cancelled claims 2 and 3, and added new claims 28 and 29. The claim amendments are generally directed to incorporating subject matter of dependent claims into the independent claims, as well as to the incorporation of medical image acquisition. Support for the new claims can be found in the specification, for example, at page 4, lines 15-19 and page 10, lines 6-9. Upon entry of the amendments, claims 1 and 4-29 will be pending in the present patent application. Applicants respectfully request reconsideration and allowance of all pending claims.

As a preliminary matter, Applicants note that the present Office Action did not clearly identify passages in the cited references, as required. *See* 37 C.F.R. § 1.104. The Examiner cited to the references by paragraph and line number. However, the references are organized by columns. Moreover, there appears to be no correspondence between the citations and the actual paragraphs of the references. Applicants respectfully request that the Examiner clarify the rejection.

Claim Rejections under 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims 26 and 27 under U.S.C. § 101 because the claimed invention is directed to not-statutory subject matter. While Applicants do not necessarily agree with the rejection, Applicants have amended claims

26 and 27 to include the language required by the Examiner. *See* Office Action, page 2. Withdrawal of the present rejection and allowance of claims 26 and 27 is therefore respectfully requested.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 2, 7-11, 13, 15, 20-22, and 24-27 under U.S.C. § 102(b) as anticipated by Boreczky et al., U.S. Patent No. 6,366,296 (hereafter "Boreczky"). Of these rejected claims, claims 1, 9, 20, 24, 25, 26 and 27 are independent. Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). Indeed, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). The prior art reference must show the *identical* invention "*in as complete detail as contained in the ... claim*" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Further, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *see also* M.P.E.P.

§§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (citations omitted). One should rely heavily on the written description for guidance as to the meaning of the claims. *See id.*, at 16.

Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." *See Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on "usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art." *See id.*

Features of the Independent Claims are Missing from Boreczky

Independent claims 1, 24, and 26, as amended, recite, *inter alia*, "wherein the plurality of images represent spatially adjacent subject matter." In contrast, Boreczky is directed to processing of video (i.e., time series of video frames), which is inapposite images of spatially adjacent subject matter. Boreczky does not contemplate comparing images of spatially adjacent subject matter, as claimed.

Further, Applicants stress it would be nonsensical to attempt to modify Boreczky to incorporate this presently-recited feature. After all, Boreczky is exclusively directed to detecting features of video which must time-sensitive by definition. Indeed, the detection of the Boreczk features (i.e. the detection of a video cut, silence, applause) would have no expectation of success if the Boreczky system were somehow modified to analyze the presently-recited images. In view of the foregoing, independent claims 1, 24, and 26, and the claims depending from claim 1, are patentable over Boreczky.

Independent claim 9, as amended, recites, *inter alia*, "*acquiring* a plurality of *reconstructed* images via a medical imaging system," and "comparing image data representative of the plurality of *reconstructed images*." Conversely, Boreczky does not teach the *acquisition* of images, much less the acquisition of *reconstructed* images or acquisition of images via a medical imaging system. Instead, Boreczky is directed exclusively to the analysis (not acquisition) of video (not reconstructed images). Further, Boreczky also does not teach or suggest the *comparison* of such images. For these reasons, independent claim 9 and its dependent claims are patentable over the cited reference.

All independent claims, as amended, generally recite the *acquisition* of images via a *medical imaging* system. In stark contrast, Boreczky is absolutely devoid of the acquisition of images, much less the acquisition of images via a

medical imaging system. Instead, again, Boreczky is completely directed to the analysis and viewing of video. Therefore, all claims are believed to patentable over Boreczky. In view of the foregoing discussion, Applicants respectfully request that the Examiner withdraw the rejection and allow the claims.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 3 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Boreczky et al (U.S. Patent No. 6,636,296) in view of Karimi et al. (U.S. Patent No. 6,813,374); claims 4, 5, 17 and 18 as being unpatentable over Boreczky et al (U.S. Patent No. 6,636,296) in view of Apicella et al. (U.S. Patent No. 5,273,040); claim19 as being unpatentable over Boreczky et al (U.S. Patent No. 6,636,296) in view of Apicella et al. (U.S. Patent No. 5,273,040) and in further view of Hsieh et al. (U.S. Patent No. 6,256,368); claim 6 as being unpatentable over Boreczky et al (U.S. Patent No. 6,636,296) in view of Hsieh et al. (U.S. Patent No. 6,256,368); claim 12 as being unpatentable over Boreczky et al (U.S. Patent No. 6,636,296) in view of the guide "getting started with Microsoft windows 98" by Microsoft; claims 14 and 23 as being unpatentable over Boreczky et al (U.S. Patent No. 6,636,296). All claims rejected under 35 U.S.C. § 103(a) are dependent claims. Applicant respectfully traverses these rejections.

Applicant respectfully asserts that while the present dependent claims are patentable by virtue of their dependency on an allowable independent claim, the

dependent claims are also patentable because of the subject matter they separately recite. Moreover, the secondary references cited by the Examiner do not obviate the deficiencies discussed above. Accordingly, Applicant respectfully requests withdrawal of the rejections under § 103.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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